

REMARKS

I. Status of the Claims

In the Office Action mailed on February 11, 2008, the Examiner rejected claims 1-3, 6, 7, 10, 13-15, 18, 19, 22, 25-27, 30, 31, and 34 under 35 U.S.C. § 103(a) as being unpatentable over *Bank Marketing* (Jan/Feb 2001, Volume 33, Issue 1. pp. 14-15) in view of *The Star Tribune* (Minneapolis, MN, May 10, 1997, p. 3); rejected claims 4, 16, 28, and 29 under 35 U.S.C. § 103(a) as being unpatentable over *Bank Marketing* and *The Star Tribune*, and in further view of *The Sunday Telegraph* (London, UK, Apr. 7, 2002, p. 10); rejected claims 5 and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Bank Marketing*, *The Star Tribune*, and *The Sunday Telegraph*, and in further view of *The Wall Street Journal* (New York, NY, Jan. 22, 2003, p. D1);¹ and rejected claims 8, 9, 11, 12, 20, 21, 23, 24, 32, 33, 35, and 36 under 35 U.S.C. § 103(a) as being unpatentable over *Bank Marketing News* and *The Star Tribune*, and in further view of *The Washington Post* (Washington, DC, Feb. 12, 2003, p. 5).

By this amendment, Applicants amend claims 1, 5, 13, 17, 25, and 29, and cancel claims 4, 16, and 28 without prejudice or disclaimer. However, by amending these claims, Applicants have not acceded to any of the outstanding rejections. To the contrary, Applicants respectfully traverse the rejections contained in the Office Action. Claims 1-3, 5-15, 17-27, and 29-36 are pending and under current examination.

¹ The Office Action rejects claims 5 and 17 in view of *Bank Marketing*, *The Sunday Telegraph*, and *The Washington Post*. However, it appears that the Office Action intended to rely on *The Wall Street Journal* and not *The Washington Post* in this rejection. Accordingly, this response treats claims 5 and 17 as being rejected in view of *Bank Marketing*, *The Sunday Telegraph*, and *The Wall Street Journal*.

II. Rejections of Claims 1-3, 5-15, 17-27, and 29-36 Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejections of claims 1-3, 5-15, 17-27, and 29-36 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established for at least the following reasons.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. *See id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.”

M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Amended independent claim 1 recites a method for offering a credit card account to a consumer comprising:

determining if the consumer is a potential purchaser of real estate;

offering a credit card account to the consumer if the consumer is a potential real estate purchaser;

transferring a balance to the credit card account equal to at least a portion of closing costs associated with the purchase of the real estate by the consumer;

setting a discounted interest rate on the account balance corresponding to the closing costs transferred to the credit card account, wherein the discounted interest rate is less than the interest rate applied to the balance associated with transactions other than the closing costs; and

providing a predetermined discount to the consumer for items purchased by the consumer using the credit card account.

Bank Marketing, The Star Tribune, The Sunday Telegraph, The Wall Street Journal, and The Washington Post, taken individually or in any proper combination, fail to disclose the claimed method of offering a credit card account.

On the contrary, *Bank Marketing* discloses the cross-selling of bank services, such as home-equity loans to new mortgage holders (*Bank Marketing*, p. 14) and *The Star Tribune* discloses the cross-selling of a "plastic card [that] will function as a guaranteed loan pre-approval for a maximum mortgage amount, good for six months." (*The Star Tribune*, p. 3.) *The Washington Post* discloses the use of incentives, such as discounts off purchases and rebates offered to consumers who purchase with store credit cards. (*The Washington Post*, p. 5.) *The Sunday Telegraph* discloses the

offering temporary low finance rates on balances transferred to a credit card from another credit card (*The Sunday Telegraph*, p. 10) and *The Wall Street Journal* discloses the offering of temporary 0% finance rates on balances transferred from competing credit cards. (*The Wall Street Journal*, p. D1.) None of the references disclose “setting a discounted interest rate on the account balance corresponding to the closing costs transferred to the credit card account, wherein the discounted interest rate is less than the interest rate applied to the balance associated with transactions other than the closing costs,” as recited in amended claim 1. In addition, the Office Action does not demonstrate that the recitations of amended claim 1 would have been obvious to one of ordinary skill in the art.

Independent claims 13 and 25, while of different scope than claim 1, distinguish over *Bank Marketing*, *The Star Tribune*, *The Sunday Telegraph*, *The Wall Street Journal*, and *The Washington Post* for at least the same reasons as claim 1. Accordingly, Applicants also respectfully request the withdrawal of the rejection of claims 13 and 25 under 35 U.S.C. § 103(a) and the timely allowance of the claims.

Dependent claims 2, 3, 5-12, 14, 15, 17- 24, 26, 27, and 29-36 are also allowable at least for the reasons set forth above in connection with independent claims 1, 13, and 25. Accordingly, Applicants also respectfully request withdrawal of the rejection of dependent claims 2, 3, 5-12, 14, 15, 17- 24, 26, 27, and 29-36 under 35 U.S.C. § 103(a) and the timely allowance of these claims.

CONCLUSION

The preceding remarks are based on the on the arguments presented in the Office Action and, therefore, do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The pending claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding remarks in favor of patentability are advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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